

REMARKS

This communication is in response to the Office Action issued July 14, 2004. The Examiner rejected claims 1, 2, 4-6, 8-11, 13, 19, 21, 22, 26-28, 32, 37, and 45 under 35 U.S.C. § 102 in view of European Patent Publication No. 0285844 A2 to Antonious (“Antonious”) or U.S. Patent No. 6,290,609 to Takeda (“Takeda”). The Examiner rejected claims 3-5, 7-11, 14, 17, 18, 20, 33, 34, 41, and 43 under 35 U.S.C. § 103 in view of one or more of Antonious, Takeda, and U.S. Patent No. 5,944,619 to D. Cameron (“Cameron”). The Examiner indicated that claims 15, 16, and 23-25 were allowable.

Claim Rejections Under 35 U.S.C. § 102

In sections 1-2 of the Office Action, the Examiner rejected claims 1, 2, 4-6, 8-11, 13, 19, 21, 22, 26-28, 32, 37, and 45 under 35 U.S.C. § 102 in view of Antonious or Takeda. Specifically, the Examiner rejected claims 1, 2, 4-6, and 45 in view of Antonious, and claims 1, 2, 6, 8-11, 13, 19, 21, 22, 26-28, 32, 37, and 45 in view of Takeda.

It is well settled that for a rejection of a claim under 35 U.S.C. § 102 to be proper, each and every element as set forth in the claim must be found in a single reference. See, for example, MPEP § 2131. For at least the reasons stated below, the Examiner’s rejections of the claims do not satisfy this burden.

Claims 1, 2, 4-6, and 45

Antonious appears to disclose a cavity-back golf club head with elongated weight members (e.g., 30, 32) trifurcating the cavity. However, in addition to having a cavity, the instant claims require a plurality of recesses, with the recesses extending away from the cavity. The Antonious club head does not have a plurality of recesses, let alone a plurality of recesses extending away from the cavity. The Examiner did not specify which elements of the Antonious

club head satisfied these recitations. However, the figures cited by the Examiner make clear that the Antonious golf club does not satisfy these requirements.

Since the cited reference does not disclose each of the claim recitations, the rejections are improper and must be withdrawn.

Claims 1, 2, 6, 8-11, 13, 19, 21, 22, 26-28, 32, 37, and 45

Takeda appears to disclose a golf club head with a cavity (14). In some embodiments, the cavity has a plurality of grooves (12) therein. However, these grooves extend in the same direction as the cavity, and thus do not extend away from the cavity as required by the instant claims. See, for example, figure 3 of the instant application, which shows three recesses (25, 26, 27) extending away from the cavity (20) and into the sole (13). See also the written description at, for example, page 5, line 15 to page 6, line 8.

Since the cited reference does not disclose each of the claim recitations, the rejections are improper and must be withdrawn.

Conclusion of § 102 Rejections

Having established above that neither of the cited references satisfy the requirements of the instant claims, the Examiner's rejections under 35 U.S.C. § 102 to the claims are believed to be overcome.

Claim Rejections Under 35 U.S.C. § 103

In sections 3-5 of the Office Action, the Examiner rejected claims 3-5, 7-11, 14, 17, 18, 20, 33, 34, 41, and 43 under 35 U.S.C. § 103 in view of one or more of Antonious, Takeda, and Cameron. Specifically, the Examiner rejected claims 3 and 7-11 in view of Antonious, claims 3-

5, 7, 14, 17, 18, 20, 33, 34, 41, and 43 in view of Takeda, and claims 12, 29-31, 35, 36, 38-40, 42, and 44 in view of Takeda modified by Cameron.

Each of claims 3-5, 7-11, 14, 17, 18, 20, 33, 34, 41, and 43 ultimately depends from claim 1, the allowability of which is established above. Thus, each of claims 3-5, 7-11, 14, 17, 18, 20, 33, 34, 41, and 43 is also allowable for at least the same reasons as claim 1.

In view of the foregoing, the Examiner's rejections under 35 U.S.C. § 103 to the claims are believed to be overcome.

Allowable Subject Matter

On page 8 of the Office Action, the Examiner indicated that claims 15, 16, and 23-25 were allowable. The Applicants appreciate the Examiner's indication of allowable subject matter.

Additional Fees

The Commissioner is hereby authorized to charge any insufficiency or credit any overpayment associated with this application to Swidler Berlin Shreff Friedman, LLP Deposit Account No. 19-5127 (order no. 20003.0078).

Conclusion

Claims 1-43 are pending in the application, and are believed to be in condition for allowance. In view of the foregoing, all of the Examiner's rejections of the claims are believed to be overcome. The Applicants respectfully request reconsideration and issuance of a Notice of Allowance for all claims. Should the Examiner feel further communication would help

prosecution, the Examiner is urged to call the undersigned at the telephone number provided below.

Respectfully Submitted,



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